

## REMARKS

Claims 1-32 are currently pending in the application. Claims 1, 14, 21, and 27 are independent claims and claims 2-13, 15-20, 22-26, and 28-32 depend, respectively, from the independent claims. The Applicants request reconsideration of the claims in light of the following remarks.

This application was filed in October 2000, nearly five years ago. In 2003, Applicants received their first action, a rejection claiming that the pending claims were obvious in light of the Katz and Palmer references. Rather than specifically identifying where the references taught the claimed invention, the Office instead repeatedly used a lengthy string cite, which included thirty-six cites, as well as a catch-all of the “whole document,” to support of its conclusion that the references disclosed the claim invention.<sup>1</sup> Applicants obviously objected to the Office’s approach and requested that the Office provide further detail as to where these references disclose or teach the claimed invention. Applicants also traversed the Office’s rejection, noting that, among other things, the cited reference did not teach “associating a coupon with an item being purchased online, wherein the coupon may be redeemed during the online purchase.”

In April 2004, the Office issued its second rejection, this time finding that the pending claims were obvious in light of Nichtberger. Because the Office no longer relied upon the Katz and Palmer references, the Office did not address the issues raised in Applicants’ response, thereby

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<sup>1</sup> The citation, which the Office relied upon in rejecting each of the claim limitations, was as follows: Palmer (the ABSTRACT; FIG. 1 through FIG. 9; col. 1, ll. 1-67; col. 2, ll. 1-67; col. 3, ll.1-67; col.4, ll. 1-67; col. 5, ll. 1-67; and col. 6, ll. 1-50) in view of Katz (the ABSTRACT; FIG. 6; col. 2, ll. 55-67; col. 3, ll. 15-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 11, ll. 30-67; col. 13, ll. 25-67; col. 14, ll. 39-67; col. 17, ll. 36-67; col. 18, ll. 1-15; col. 23, ll. 60-67; col. 24, ll. 1-5; col. 26, ll. 66-67; col. 27, ll. 1-22; col. 28, ll. 20-29; and whole document) shows . . .”

inherently adopting Applicants' argument that neither the Katz nor the Palmer references taught or disclosed the claimed invention.

Prior to responding to the Office's second rejection, Applicants' attorney had an interview with the Examiner, in which the Examiner conceded that the claimed invention was not obvious in light of the Nichtberger reference that he previously cited:

It appears to the Examiner that the claims of the instant invention suffer from undue breadth, even though arguments during this interview by Applicant's representative tend to show that the Nichtberger reference applied in the obviousness rejections of the prior Office action does not show the 'online purchase request from a buyer . . .' feature recited in claim 1 of the instant invention.

(See Interview Summary from May 5, 2004 interview.) Rather than withdrawing the rejection, however, the Examiner noted that a further search was necessary because a preliminary search conducted by the Examiner during the interview uncovered two references (the Mankoff and Messner references), which allegedly taught the redemption of coupons in connection with an online purchase.

The Applicants then filed a response to the second rejection, reiterating that the Nichtberger reference differed from the claimed invention because, among other things, "Nichtberger does not disclose an online purchase request." In addition, the Applicants noted that neither the Mankoff nor the Messner references, which were cited during the interview, constituted prior art because the Applicants have an earlier priority date.

In response to the Applicants' argument, the Office issued a third formal rejection, this time relying on its sixth different prior art reference, the Berger reference. Much like with the first rejection, in this 64-page Office action the Office again failed to provide any particular citation as to where the Berger reference allegedly teaches or discloses the claimed invention. Instead, the Office

relied on the following string cite, which encompasses 19 figures and over 1,250 lines of disclosure (not including the “whole document” catch-all):

It would have been obvious to one of ordinary skill in the art at the time of the invention that the above cited disclosure of Berger (col. 19, ll. 67-67; and col. 20, ll. 1-10), as well as Berger (FIG. 1B; FIG. 1C; FIG. 3; FIG. 4; FIG. 6A; FIG. 9; FIG. 15A; FIG. 15B; FIG. 18A; FIG. 20A; FIG. 20B; FIG. 20C; FIG. 22; FIG. 28; col. 6, ll. 23-26; FIG. 31; FIG. 33; FIG. 34; FIG. 35; FIG. 40; col. 15, ll. 29-67; col. 16, ll. 1-67; col. 17, ll. 1-67; col. 18, ll. 1-67; col. 19, ll. 1-67; col. 20, ll. 1-67; col. 21, ll. 1-67; col. 22, ll. 1-67; col. 23, ll. 1-67; col. 24, ll. 15-67; col. 25, ll. 1-67; col. 37, ll. 65-67; col. 38, ll. 1-67; col. 61, ll. 17-67; col. 62, ll. 1-67; col. 123, ll. 13-67; col. 124, ll. 1-67; col. 138, ll. 35-67; col. 139, ll. 32-67; col. 140, ll. 1-67; col. 145, ll. 13-67; col. 141, ll. 15-67; col. 19, ll. 67-67; and col. 20, ll. 1-10; and whole document) implicitly shows [the claimed limitation].

The Office simply reiterated this lengthy cite for each limitation of the pending claims. Clearly such a vague rejection is inappropriate.

In the event that the Office relies upon a prior art reference to reject pending claims, the Code of Federal Regulations requires that the Office identify “the particular part [of the cited reference] relied upon . . . as nearly as practicable.” *See* 37 CFR 1.104(c)(2) (2004). Clearly the Office’s attempt to rely upon 19 figures and over 1,250 lines of disclosure does not comply with this requirement. As such, in the event that the office intends to maintain this objection, Applicants request that the Office identify the particular portions of the Berger reference that form the basis of this rejection, as is required by the Regulations.

Regardless of the Office’s failure to particularly identify the relevant portions of the Berger reference, Applicants assert that the claims are not obvious in light of the Berger reference because the Berger reference fails to teach (or even suggest) the claimed invention. Unlike the claimed invention, the Berger reference deals with a “system . . . for processing a plurality of transactions from a single initiation point.” (*See* Berger, col. 1, ll. 12-13.) As noted

in Berger, it is allegedly desirable for a merchant to obtain and transmit information that is transmitted over a publicly accessible network (such as the Internet), without risking the exposure of the information to interception by third parties that have access to the network. (*Id.* at col. 2, ll. 26-34.) As such, the Berger reference discloses a system in which separate payment transactions are each assigned a unique token value, which helps insure that unauthorized parties are unable to gain access to the details of the transaction. (*Id.* at col. 4, ll. 30-61.)

While the Berger reference may generally relate to offering goods for sale online, clearly the Berger reference is in no way related to processing another party's coupons or promotions in connection with such a sale. Nowhere does the Berger reference disclose or suggest at least the following limitations of claim 1: "A method of processing a coupon of a first party," "offering, by a second system of a second party, an item online for sale at a sales price amount," "associating the coupon of the first party with the item, the coupon having a coupon amount," or "responding, by the second system, to the online purchase request by collecting from the buyer a purchase amount corresponding to the sales price amount less the coupon amount for the item." Berger likewise fails to disclose similar limitations in independent claims 14, 21, and 27. Even more telling is the fact that the Berger reference, which is approximately 150 pages long, only mentions the word "coupon" or "promotion" on one occasion. (*See*, col. 141, ln. 9, which ironically was not one of the 1,250 lines relied upon by the Office). Clearly Berger is not analogous to the claimed invention.

While the Office concedes that the Berger reference fails to disclose the claim limitations specifically related to processing coupons or promotions, the Office maintains that it would have been obvious to modify Berger to provide means of "ensuring the association of the transaction with a unique terminal identification." The Office also suggest the one would modify Berger so

that “a host legacy system evaluates the payment information and returns a level of authorization of credit to the gateway which packages the information to form a secure transaction which is transmitted to the merchant which is in turn communicated to the customer by the merchant.” Such assurances, however, are completely irrelevant to the problems faced by Applicants, which in general consists of redeeming coupons or promotions in connection with online purchases. There is simply no connection between the two references, and as such no motivation to modify Berger, which deals with securely transmitting payment information, to come up with the claimed invention. As such, Applicants respectfully request that the rejection in light of Berger be withdrawn.

Because the Berger reference fails to disclose all of the limitations of claims 1-32, Applicants respectfully assert that the claims are allowable over the Berger reference.

### CONCLUSION

Applicants believe that all of claims 1-32 are in condition for allowance. Should the Examiner disagree or have any questions regarding this submission, Applicants invite the Examiner to telephone the undersigned at (312) 775-8000.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

Dated: August 8, 2005

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